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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,628	06/28/2001	Susumu Nakagawa	450100-03297	6151
20999 7590 05/18/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/894,628

Applicant(s)

NAKAGAWA, SUSUMU

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-3, 6, 7, 9 and 10 have been examined.

***Response to Amendments***

2. The newly added language of "receiving contents and content usage rights information from a contents distribution server in response to a user request at a memory storage device remote from the user" is not clear to one of ordinary skill and is being interpreted as follows:
  - A server receiving a request for content from a first device and delivering the content to a second device along with rights information

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite "receiving contents and content usage rights information from a contents distribution server in response to a user request at a memory storage device remote from the user". Applicant's Specification are silent such a request. Applicant disclose two computer configurations for rendering content, figure 1, which depicts a PC (Specification, page 9, lines 5-13) and figure 8, which describes a device which receives data from a remote server and distributes the data to a plurality of local terminals (e.g. PCs, television receivers) (Specification, page 27, lines 5-20). However, neither embodiment teaches a user requesting content from a storage medium remote from the user and downloading the requested content to the remote medium. The Specification is also silent receiving content and content usage rights information in response to a request. Claims 7, 9 and 10 are also rejected as each recites language similar to claim 1.

Claims 2, 3 and 6 are also rejected as each depends from claim 1.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to recite "receiving contents and content usage rights information from a contents distribution server in response to a user request at a memory storage device remote from the user". Applicant disclose two computer configurations for rendering content, figure 1, which depicts a PC (Specification, page 9, lines 5-13) and figure 8, which describes a device which receives data from a remote server and distributes the data to a plurality of local terminals (e.g. PCs, television receivers) (Specification, page 27, lines 5-20). If the claims are directed to the embodiment of figure 1, then a user making a request [from] a "memory storage device remote from the user" is not apparent. On the other hand, if the claims are depicting figure 8, then it is not clear to one of ordinary skill whether the "memory storage device remote from the user" from where the request is made is a "content control device" or a client terminal such as a PC. Claims 7, 9 and 10 are also rejected as each recites language similar to claim 1.

Claims 2, 3 and 6 are also rejected as each depends from claim 1.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin et al., U.S. Patent No. 6,697,948 in view of Venkatesan et al., U.S. Patent No. 6,801,999 and Payton, U.S. Patent No. 5,790,935.

As per claims 1-3, 6, 7, 9 and 10, Rabin et al. teach method and system for managing content comprising:

- Key code monitoring means for comparing usage rights (e.g. number of times or period of time content can be used) with usage status and determining whether content (column 26, lines 32-60) usage is within the range according to content usage information (column 5, lines 8-28 and 35-54; column 59, lines 38-56)
- disabling content if status code information exceeds usage rights (column 5, lines 44-48; column 19, lines 48-57; column 23, lines 15-25; column 59, lines 37-56)
- function for outputting usage status (column 18, lines 55-60)

Rabin et al. disclose content licensing (or usage rights information) (column 59, lines 36-57). Rabin et al. do not explicitly teach transmitting the license (or usage rights information) along with the content. However, to one of ordinary skill this is

at least suggested as the computer of Rabin et al. refers to data such as content policy for controlling content (column/line 47/45-48/8) which is typically found in a license. Sending a license (or usage rights information) with its associated content is old and well known, therefore it would have been obvious to one of ordinary skill to send a license with the content wherein the license stores for example, a license expiration date, to enable instant deactivation of content instead of relying on a vendor recognizing that a user has yet to renew her/his license (column 59, lines 36-57). Regarding deleting content, Rabin et al. disclose "punitive measures" (column 23, lines 16-25) as severe as disabling a computer. Rabin et al. also teach previously installed software with a status such as "removed" (figure 6; column 42, lines 13-23). To one ordinary skill, the prior art at least suggests removing the content from the user computer. Further, it is well known to those of ordinary skill in law to create and receive audit trail of actions performed in order to protect a business [content] owner against possible legal action. Rabin et al. teach distributing usage records to a remote center (column 18, lines 55-60). A well known method for exchanging data over the internet is via email.

According to the MPEP (section 2106, II, C) language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim

limitation. Hence, the outputting of invalidation reports does not distinguish the claims from the prior art, for if content is not disabled or deleted a report is not sent. Rabin et al. do not specifically recite generating a warning code.

Venkatesan et al. teach generating a warning code to a user informing the user of actions required to be taken to ensure continued use of a product (column 34, lines 8-29). However, neither Rabin et al. nor Venkatesan et al. teach "receiving contents and content usage rights information from a contents distribution server in response to a user request at a memory storage device remote from the user". Payton teaches a server receiving a request for content from a first device and delivering the content to a second device (figure 1; column 4, lines 45-54; column 6, lines 20-50; column/line 7/60-8/25; column/line 9/60-10/20). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rabin et al., Venkatesan et al. Payton to allow multiple users in a home to access content along the same network connection ('935, figure 1) and to remind each user to send a call-up message in order to avoid punitive measures such as disabling of a user computer ('948, column 23, lines 16-25).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

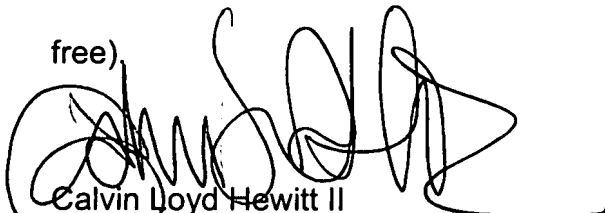


- Ginter et al. teach distributing content to a user with its associated license or usage rights information

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Calvin Loyd Hewitt II  
Primary Examiner

May 10, 2007